

- 1
- 2
- 3
- 4
- 5
- 6
- 7
- 8
- 9
- 10
- 11
- 12
- 13
- 14
- 15
- 16
- 17
- 18
- 19
- 20
- 21

In the Office Action dated July 7, 2003, the Examiner rejected claims 31-48 under 35 U.S.C.

§ 103. In the following remarks, applicants will respond to those rejections and highlight the differences between the pending claims and the cited references such that it becomes apparent to the Examiner that these rejections should be reconsidered and withdrawn. Applicants have amended the claims to more clearly define the unique an non-obvious features of the present invention.

The Examiner rejected claims 31-48 under 35 U.S.C. § 103(a) as being unpatentable over Montgomery, U.S. Patent No. 5,098,696 (“Montgomery”) in view of Pagano et al., U.S. Patent No. 5,772,988 (“Pagano”) and Beaver, U.S. Patent No. 5,830,442 (“Beaver”). Applicants respectfully

1 submit that the Examiner's application of the teachings of the cited references is misplaced. Applicants
2 disagree with the Examiner's opinion as to the specific teachings of the cited references and any
3 resulting combination thereof. In addition, the Examiner's rejection could only be the result of hindsight
4 reconstruction of the applicants' invention. More importantly, even if the cited references were properly
5 combined, such combination still would not teach all of the novel and non-obvious features of the
6 present invention as claimed.

7 As previously discussed during the prosecution of the present invention, Montgomery neither
8 teaches nor suggests the amounts of a multicarbonyl vinyl containing monomer needed to achieve the
9 improved results as disclosed and claimed by the applicants for the present invention. In fact,
10 Montgomery does not teach the use of monomers at all, nor does Montgomery even suggest the
11 addition of effective amounts of a multicarbonyl vinyl containing monomer for any purpose.

12 As discussed during the telephonic interview, Pagano discloses a composition for a nail enamel.
13 The art of creating a nail enamel is distinct from the art of creating an artificial nail composition. Nail
14 enamels typically comprise a polymer dissolved in a solvent, whereby through the process of
15 evaporation, the polymer temporarily adheres to the nail plate via hydrogen bonds typically for a period
16 of approximately three days. In contrast, the artificial nail composition of the present invention utilizes
17 monomers. These monomers react in situ, forming polymers with the keratin of the nail plate, itself
18 behaving as a reactant to form an artificial nail. The covalent bonds formed with the nail plate result in
19 adhesion lasting about three to six months, depending on the growth rate of the natural nail. On this
20 basis, we respectfully submit that Montgomery (dealing with artificial nail compositions), and Pagano
21 (relating to nail enamels) are nonanalogous art, and thus the combination asserted by the Examiner is

1 improper and should be reconsidered.

2 Furthermore, Pagano uses a monoethylenically unsaturated vinyl monomer with plural carboxyl
3 groups (i.e., AAEMA), and he teaches reacting 20% by weight AAEMA to form a polymer. The
4 carbonyl groups are converted to hydroxy functional groups and thus the polymer becomes a
5 completely different chemical than the AAEMA monomer and is only capable of forming hydrogen
6 bonds with the keratin of the nail plate. While the applicants have determined that Pagano is non-
7 analogous art to the present invention, the artificial nail composition of the present invention preferably
8 incorporates the multicarbonyl-vinyl containing monomer at less than 20% by weight. Applicants have
9 amended the claims and the specification such that even if reliance on Pagano was appropriate, the
10 claims as amended now avoid Pagano and are in condition for allowance.

11 Consequently, none of the references relied on by the Examiner teach or suggest each and
12 every element of the claimed invention of the pending claims. In fact, none of the cited references teach
13 or suggest an artificial nail composition comprising multicarbonyl-vinyl containing monomer, which
14 provides for improved adhesion through covalent bonding to the nail plate. Therefore, applicants
15 submit that the rejection of Claims 31-48 as being unpatentable over Montgomery or Pagano or
16 Beaver should be reconsidered. Upon closer review of the cited references and in view of the
17 amendments and remarks made herein above, applicants submit that it will be apparent to the Examiner
18 that the rejection of Claims 31-48 under 35 U.S.C. § 103(a) should be withdrawn.

19 Despite the fact that a combination of the cited references does not teach the claimed invention,
20 applicants submit that the obviousness argument advanced by the Examiner is merely an "obvious to
21 try" argument. In fact, each of the compositions disclosed in Montgomery, Pagano, and Beaver are

1 unsuitable for forming an artificial nail with improved adhesion to the nail plate. Accordingly, it cannot
2 be said that the present invention is obvious in view of any of Montgomery, Pagano, and Beaver either
3 alone or in combination. At best it might be "obvious to try" such a combination, which, of course, is
4 not the standard for obviousness under 35 U.S.C. §103. *Hybritech, Inc. v. Monoclonal Antibodies,*
5 *Inc.*, 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).


6 Under the circumstances, applicant re-submits that the Examiner has succumbed to the "strong
7 temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012,
8 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983). The only "motivation" for the Examiner's obviousness
9 argument in view of the cited references is provided by the teachings of applicants' own disclosure. No
10 such motivation is provided by the references themselves.

11 Therefore, as is evidenced by the above amendments and remarks, the present invention, for
12 the first time, discloses an artificial nail composition consisting of an ethylenically unsaturated monomer
13 and a monoethylenically unsaturated vinyl monomer that contains two or more carbonyl groups. The
14 monomer composition reacts in situ with the keratin of the nail plate to form an improved artificial nail.
15 An artificial nail composition such as this is neither taught nor suggested anywhere in the cited
16 references.

1 Applicants therefore submit that claims 31-48 represent a novel and patentable contribution to
2 the art and that the application is in condition for allowance. Early and favorable action is respectfully
3 requested.

Respectfully submitted,

Date: April 30, 2004


John F. Ward
Reg. No. 33,811
WARD & OLIVO
708 Third Avenue
New York, New York 10017
(212) 697-6262